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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/838,698	04/19/2001	N. Kelley Grusin	33758.22.1	8976

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WRIGHT MEDICAL TECHNOLOGY, INC.
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EXAMINER

BARRETT, THOMAS C

ART UNIT PAPER NUMBER

3738

DATE MAILED: 10/30/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/838,698

Applicant(s)

GRUSIN ET AL.

Examiner

Thomas C. Barrett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-10 and 12-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 20 is/are allowed.
- 6) ☒ Claim(s) 1,4-6,9,10,12-15,18,19 and 21 is/are rejected.
- 7) ☒ Claim(s) 7,8,16 and 17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 January 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 19. 6) ☐ Other: _____

DETAILED ACTION

REQUEST FOR CONTINUED EXAMINATION

The request filed on October 16 2003 for a Request for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/838698 is acceptable and a RCE has been established. An action on the RCE follows.

Response to Arguments

Applicant's arguments with respect to claims 1-2, 4-10, and 12-21 have been considered but are moot in view of the new ground(s) of rejection.

Contrary to the Applicant's arguments, Tornier does anticipate the invention as claimed. The first connector of Tornier can rotate 360 degrees in the bore of the humeral head, thereby providing an infinite number of second degrees of eccentricity; it is the locking member of Tornier that limits the cap positions based upon the holes (34) into predetermined positions, just as the detents of the present invention places the first portion of the connecting member into predetermined positions relative to the humeral head.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 15.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: 13 and 72. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 12-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12 recites the limitation "stem" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

And

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section

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351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 4-6, 9-10, 12-15 and 18-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Tornier (5,358,526). Tornier discloses a modular shoulder prosthesis comprising: a stem (1), a generally spherical surfaced head (3) with a bore (33), a connecting member (2), and a threaded locking piece in the form of a screw having a tool engaging surface (7, col. 5, lines 5-8). The bore of the head is positioned non-coaxially with the spherical surfaced (Fig.1). The second portion of the connector can have a Morse taper (Fig. 1, 22), or a dove-tail (Fig. 7, 20'). There are recesses within the bore (Fig. 5, 34) for engaging a detent (5) on the first member.

Claim 21 is rejected under 35 U.S.C. 102(e) as being anticipated by Pearl (6,589,282 B1). Pearl discloses a modular shoulder prosthesis comprising: a stem (11 and 12), a generally spherical surfaced head (13) with a bore (19), a connecting member (14), and a locking member (24). The bore of the head is positioned non-coaxially with the spherical surfaced (Fig.1C). The first and second portions of the connector have parallel surfaces and are non-coaxial with each other (Fig. 1B, ref. 15 and 17). The first connector portion can be in the shape of a cylinder and therefore is configured for rotatable insertion in the axial bore of the humeral head (col. 5, lines 11-34). Please Note: The stem (11) and body (12) combination of Pearl is being broadly interpreted as the stem as claimed in the present invention and shown in Fig.10 of the present invention, therefore the second portion of the connector is immediately adjacent the stem.

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Allowabl Subject Matter

Claims 7-8 and 16-17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 20 is allowable over the prior art of record.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas C. Barrett whose telephone number is (703) 308-8295. The examiner can normally be reached Tuesday-Friday between 9:00 A.M. and 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (703) 308-2111. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3580 for regular communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308 0850.

A handwritten signature in black ink, appearing to read 'Thomas Barrett', with a stylized flourish extending to the right.

Thomas Barrett
October 28, 2003